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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,575	08/16/2001	Scott G. Newnam	58850/G476	2412
23363 7590 10/30/2007 CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/931,575	Applicant(s) NEWNAM ET AL.	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/03/2007 and 09/25/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 08/03/2007.
2. Claims 1-27 are presented for examination.
3. Amendments to claims 1, 6, 7, 17, 24, and 27 have been entered and considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. *Claim 27 is rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter. 35 U.S.C 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). The applicants claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C 101. The claim begins by discussing a system (ex. claim 27: a system for enhancing a broadcast event), but subsequently the claims then deal with the specifics of a method (the step of providing interactive content, identifying different devices, selecting and transmitting base software programs, and providing messages) (see rejection of claims under 35 U.S.C 112, second paragraph below, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 U.S.C 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).*

Claim Rejections - 35 USC § 112

5. *The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

6. *Claim 27 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

Claim 27 is not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. The claims begin by discussing a system (ex. claim 27: a system for enhancing a broadcast event), but subsequently the claims then deal with the specifics of a method (the step of providing interactive content, identifying different devices, selecting and transmitting base software programs, and providing messages). The claim is interpreted as a system claim. Appropriate clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. *Claims 1-3, 6, 8, 10-14, 17-19, 22, and 27 are rejected under U.S.C. 103(a) as being unpatentable over Shoff et al. (Publication Number US 2001/0001160 A1 hereinafter Shoff) in view of Grube (6,026,366 hereinafter Grube).*

In reference to claims 1 and 27, Shoff discloses a method and system for enhancing a broadcast event comprising: providing interactive (i.e. supplemental) content from a server system to remote users (abstract, page 3 paragraph 35, and Figure 2) over a data communications network (abstract and page 2 paragraph 17), the content related to the broadcast event (page 4 paragraphs 48-50), the remote users having local devices *configured to store the interactive content* (page 4 paragraph 51 and page 5 paragraph 55); and during the broadcast event, the server system providing to the plurality of different types of local devices over the data communications network messages that identify the content and cause the local devices to display the stored content locally (page 2 paragraph 17 and page 4 paragraph 51).

Shoff does not specifically teach identifying by the server system what different types of local devices are to provide interactivity with the interactive content; selecting by the server system a plurality of different base software programs for the identified types of local devices; transmitting by the server system over a data communications network a corresponding one of the plurality of selected base software programs to each of the plurality of different types of local devices based on the identified type; and

configuring each of the plurality of selected base software programs are to receive and interpret the messages from the server system for providing interactivity with the interactive content in accordance with requirements associated with the type of local device (Note: the underlined part is intended use and is not given any weight).

Grube teaches identifying by the server system what different types of local devices are to provide interactivity with the interactive content (i.e. the local devices transit information via a radio communication device to the host computer) (abstract, col. 2 lines 40-49, and Figure 1); selecting by the server system a plurality of different base software programs for the identified types of local devices (abstract, col. 2 lines 49-65, col. 4 lines 14 to col. 5 lines 18, and Figures 1 and 2); transmitting by the server system over a data communications network a corresponding one of the plurality of selected base software programs to each of the plurality of different types of local devices based on the identified type (abstract, col. 2 lines 65-67, col. 5 lines 19-25, and Figures 1 and 2); and configuring each of the plurality of selected base software programs are to receive and interpret the messages from the server system (col. 5 lines 38-49).

It would have been obvious to modify Shoff to include identifying by the server system what different types of local devices are to provide interactivity with the interactive content; selecting by the server system a plurality of different base software programs for the identified types of local devices; transmitting by the server system over a data communications network a corresponding one of the plurality of selected base software programs to each of the plurality of different types of local devices based on

the identified type; and configuring each of the plurality of selected base software programs are to receive and interpret the messages from the server system ensure that the broadcasted content is displayed to the users properly and to ensure that the content is only sent to actual paid subscribers.

8. In reference to claim 2, Shoff discloses a method wherein the content and messages are sent via Internet Protocol (abstract, page 1 paragraph 10, page 2 paragraph 17, page 4 paragraphs 49 and 52, and Figures 2, 3, and 5).

9. In reference to claim 3, Shoff discloses a method further comprising, in response to an advertisement being broadcast, the server system selecting one additional advertisement from a plurality of different advertisements tailored to different users, the one advertisement being related to, and for display at the same time as, the broadcast advertisement (page 2 paragraph 17, page 3 paragraph 40, page 4 paragraph 49, and Figures 3 and 8c).

10. In reference to claim 6, Shoff discloses a method wherein the broadcast event is broadcast over television, radio, or the Internet (page 1 paragraphs 2, 6, and 8, page 2 paragraphs 28-29, and Figure 2).

11. In reference to claim 8, Shoff discloses a method further comprising transmitting the interactive content before the broadcast event begins (i.e. the interactive content can be supplied separately and it can be provided beforehand on a CD) (page 2 paragraph 17, page 4 paragraphs 50 and 51, and page 5 paragraph 66).

12. In reference to claim 10, Shoff discloses a method wherein the messages do not include Internet addresses (page 2 paragraph 17 and Figure 3).

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13. In reference to claim 11, Shoff discloses a method wherein at least two of the different types of local devices are programmed to display the interactive content in a manner different from each other in terms of location of content on a display (page 6 paragraph 68-69 and 76, page 7 paragraph 78, and Figures 2, 4, 7, 8a, 8b, and 8c).

14. In reference to claim 12, Shoff discloses a method wherein the broadcast content is displayed and the broadcast content and the interactive content are provided on the same display in different windows (i.e. panes, screens, or pop-ups) (page 1 paragraph 10, page 6 paragraphs 68 and 76, page 7 paragraph 78, and Figures 1, 7, 8a, 8b, and 8c).

15. In reference to claim 13, Shoff discloses a method further comprising displaying the broadcast event, wherein the broadcast event and the interactive content are provided on the separate displays (i.e. on a television screen and a computer screen) (page 2 paragraphs 15-18 and Figures 2 and 4).

16. In reference to claim 14, Shoff discloses a method wherein the interactive content includes content applicable to multiple episodes of a broadcast event for display during each of the episodes (i.e. advertisements associated with Star Trek or Seinfeld in general) (page 3 paragraph 40 and Figure 3), and other content that is applicable to specific episodes for display during the respective specific episodes (i.e. surveys associated with that particular broadcast) (page 6 paragraph 76).

17. In reference to claim 17, Shoff *does not specifically* disclose a method wherein *each of the selected base software programs* includes a configuration file for interpreting messages.

Grube inherently teaches the method wherein each of the selected base software programs include a configuration file for interpreting messages (i.e. if a base software program is sent, and then later on the most sends a message to disable the software, the base software has to be configured to interpret the future messages from the host) (col. 5 lines 38-49). It would have been obvious to modify Shoff to include a configuration file for interpreting messages in each of the selected base software programs to enable the content provider to disable the software program in the future if the user unsubscribes from a given software program.

18. In reference to claim 18, Shoff discloses a method wherein a first type of local device is programmed to use the content from the server system in one manner and a second type of local device is programmed to use the content from the server system in another and different manner (i.e. can be used to toggle between contents by use of buttons, can be used to invoke a pop up box, can be used to see a URL on a computer screen linking to a website, and can be used to view data on a disc in the disc drive when instructed to do so by the server) (page 3 paragraphs 40-43, page 4 paragraph 51, and page 6 paragraph 70-76)

19. In reference to claim 19, Shoff discloses the method further comprising:
maintaining by the server system multiple local advertisement messages directed toward different users or groups of users (i.e. a group of users can be formed on the

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basis of the particular program the users view) (page 3 paragraphs 40 to page 4 paragraph 43, page 4 paragraph 49, page 8 paragraph 87, and Figures 3 and 4); and responsive to an advertisement being broadcast with the broadcast event, selecting by the server system one of a plurality of the local advertisements for causing that advertisement to be displayed additionally to the user at the same time as the advertisement in the broadcast event (page 3 paragraphs 40 to page 4 paragraph 43, page 4 paragraph 49, and Figures 3 and 4).

20. In reference to claim 22, Shoff discloses the method wherein the selected local advertisement is provided to a computer (page 2 paragraphs 15,16, and 29, page 4 paragraph 51, and Figure 4) and the broadcast event provided to a television (page 1 paragraph 2, page 2 paragraphs 15,16, and 29, and Figures 1 and 2).

21. Claims 4, 5, 20, and 21 are rejected under U.S.C. 103(a) as being unpatentable over Shoff in view of Stewart et al (6,414,635 hereinafter Stewart).

In reference to claims 4 and 21, Shoff does not teach the method further comprising the server system maintaining user profiles, wherein the server system selects the one additional local advertisement based on the user profiles. Stewart teaches the method further comprising maintaining user profiles, wherein the server system selects the one additional local advertisement based on the user profiles (col. 10 lines 8-20 and col. 13 lines 36-54). It would have been obvious to modify Shoff to include maintaining user profiles, wherein the server system selects the one additional local advertisement based on the user profiles to better target advertisements to users based on user preferences.

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22. In reference to claims 5 and 20, Shoff does not teach the method wherein the server system selects the one additional local advertisement based on the user's location. Stewart teaches the method wherein the server system selects the one additional local advertisement based on the user's location (col. 5 lines 18-24 and col. 13 lines 36-54). It would have been obvious to modify Shoff to include the server system selecting the one additional local advertisement based on the user's location to deliver better targeted advertisements to users based on whether the user is at home, hotel, or a gym for example that will be more relevant to the user based on the user's location at the time of the broadcast.

23. Claims 7 and 9 are rejected under U.S.C. 103(a) as being unpatentable over Shoff in view of Barton et al (6,233,389 hereinafter Barton) *and further in view of Official Notice*.

In reference to claims 7 and 9, Shoff teaches the method further comprising transmitting the interactive content to the *different types of* local devices while the event is occurring (page 2 paragraphs 16 and 17 and page 4 paragraph 50). Shoff does not teach storing and downloading this content in the local devices for later display in response to a message after the content has been transmitted. Barton teaches storing and downloading content for later display in a local device in response to a message after the content has been transmitted by using a multimedia time warping system, also known as TIVO (abstract, col. 1 lines 63 to col. 2 lines 3, col. 3 lines 19-29, and Figure 1). It would have been obvious to modify Shoff to include a system that can store content in a local device for later display in response to a message after the content has

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been transmitted to enable the user to view the content at a time that is convenient for the user and not dictated by the time of the original broadcast.

Shoff also does not teach storing the transmitted interactive content in each of the different types of local devices. Official Notice is taken that is old and well known to store transmitted interactive content in different types of devices. For example, an interactive game can be stored in a person's e-mail account accessible via a desktop computer or a cell phone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have stored transmitted interactive content in each of the different types of local devices to enable the user to access the stored content in the medium of his choice when it is convenient to the user.

24. Claims 15, 25, and 26 are rejected under U.S.C. 103(a) as being unpatentable over Shoff in view of Barton et al (6,233,389 hereinafter Barton) and further in view of Official Notice.

In reference to claim 15, Shoff does not teach the method further comprising: receiving and storing the broadcast event, the interactive content, and the messages in a recording device coupled to at least some of the local devices; and associating the timing of the messages with the programming such that the playback of the broadcast event from the recording device includes the content and messages for being provided at the same relative time as during the broadcast. Barton teaches receiving and storing the broadcast event, the interactive content, and the messages in a recording device coupled to at least some of the local devices (abstract, col. 1 lines 63 to col. 2 lines 3, col. 3 lines 19-29, and Figure 1). Barton is silent about associating the timing of the

content messages with the programming such that the playback of the broadcast event from the recording device includes the content and messages being provided at the same relative time as during the broadcast. Official notice is taken that is well known to present interactive content in a playback environment such as when a user plays a game in a playback mode and can take over the control of the game as done in Lobb et al. Patent Number 6,699,127. Additionally, it is well known that if the broadcast includes an associated URL, the URL will be retrieved accordingly at that time in a re-broadcast of the original event. It would have been obvious to modify Shoff to include receiving and storing the broadcast event, the interactive content, and the messages in a recording device coupled to at least some of the local devices and associating the timing of the content messages with the programming such that the playback of the broadcast event from the recording device includes the content and messages being provided at the same relative time as during the broadcast to enable users to view the content at a convenient time without losing the feel of the real-time interactive nature of the invention.

25. In reference to claim 25, Shoff teaches the method wherein the broadcast event includes a video signal, wherein the video signal does not include any triggers for accessing the interactive content (i.e. where there is no interactive content, no symbol is displayed for the user to click on) (page 5 paragraph 61).

26. In reference to claim 26, Shoff teaches the method wherein the interactive content is identified by the server system (i.e. at the memory location at the head end) independent of identifying information from the local devices (page 5 paragraph 59).

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27. Claim 16 is rejected under U.S.C. 103(a) as being unpatentable over Shoff in view of Official Notice.

In reference to claim 16, Shoff does not teach the method wherein the server system is responsive to a user entering data in response to content displayed during playback of a broadcast event for providing follow-on content related to the user entering data. Official notice is taken that it is well known for interactive playback storage devices to present follow-on content such as a next sequence of scenes in response to a user entering data during a playback of a broadcast event as done when a user plays a game in a playback mode and can take over the control of the game and to retry portions of the game in real-time as disclosed in Lobb et al. Patent Number 6,699,127. It would have been obvious to modify Shoff to include the method wherein the server system is responsive to a user entering data in response to content displayed during playback of a broadcast event for providing follow-on content related to the user entering data to maintain the interactive and real-time feel of a previously broadcasted program for the user and to give the user an opportunity to go back in time to experience the event as if it was happening in real-time.

28. Claim 23 is rejected under U.S.C. 103(a) as being unpatentable over Shoff in view of Lobb et al. (Patent Number 6,699,127 hereinafter Lobb).

In reference to claim 23, Shoff does not teach providing a plurality of display options for customizing a display layout of the interactive content; receiving a user selection of one of the plurality of display options; and customizing the display layout based on the user selection. Lobb teaches providing a plurality of display options for

customizing a display layout of the interactive content (col. 2 lines 51 to col. 3 lines 5, col. 4 lines 22-28 and 35-41, and Figures 9a and 9b); receiving a user selection of one of the plurality of display options (col. 4 lines 22-28 and col. 11 lines 55-59); and customizing the display layout based on the user selection (col. 4 lines 35-41, col. 13 lines 57 to col. 14 lines 7, and Figures 9a and 9b).

It would have been obvious to modify Shoff to include providing a plurality of display options for customizing a display layout of the interactive content; receiving a user selection of one of the plurality of display options; and customizing the display layout based on the user selection to enable the user to view the content from a different perspective than the one presented in the original broadcast to make the display more enjoyable for the user.

29. *Claim 24 is rejected under U.S.C. 103(a) as being unpatentable over Shoff in view of Lobb et al. (Patent Number 6,699,127 hereinafter Lobb) and further in view of Camut et al. (Patent Number 6,684,257 hereinafter Camut).*

In reference to claim 24, Shoff does not specifically teach the method wherein the plurality of display options are limited based on the type of local device identified by the server system. Camut teaches the method wherein the pluralities of display options are limited based on the type of local device identified by the server system (col. 3 lines 3-35 and Figure 2). It would have been obvious to modify Shoff to limit the plurality of display options based on the type of local device identified by the server system to ensure that users can view the content properly on a respective device.

Response to Arguments

27. After careful review of Applicant's remarks/arguments filed on 05/02/2006, the Applicant's arguments with respect to claims 1-22 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

28. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

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October 10th, 2007


RETTA YEHDEGA
PRIMARY EXAMINER